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## PATENT APPLICATION

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q61721

Tsuyoshi KITAHARA

Appln. No.: 09/708,514

Group Art Unit: 2861

Confirmation No.: 1708

Examiner: Brooke, Michael S.

Filed: November 9, 2000

For: INK-JET RECORDING HEAD AND METHOD OF MANUFACTURING THE SAME

#### REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

#### MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated March 10, 2006. Entry of this Reply Brief is respectfully requested.

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**STATUS OF CLAIMS**

Claims 1, 3, 4, 7 and 54 are pending in the Application, of which claim 7 was withdrawn as being directed to a non-elected invention in the July 12, 2004 Response to the June 10, 2004 Restriction Requirement. Since the June 10, 2004 Restriction Requirement indicates that claim 1 is generic, and claim 7 depends from claim 1, Applicant has not canceled claim 7.

Accordingly, claims 1, 3, 4 and 54 currently stand rejected and are the basis of this appeal.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

As set forth in the January 13, 2005 Appeal Brief:

A. Claim 1 stands rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by JP 08-187868 to Nakamura et al. (“Nakamura”).

B. Claims 3, 4 and 54 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nakamura in view of U.S. Patent No. 6,158,847 to Usui et al. (“Usui”).

C. Claim 7 as previously rejected under 35 U.S.C. § 103(a) over Nakamura in view of JP 06-023982 to Okazawa et al. (“Okazawa”). (Appellant understands that claim 7 has been withdrawn subsequent to the April 21, 2004 Appeal Brief. However, since claim 1 is considered to be generic, Appellant incorporates the previous arguments provided for claim 7, as set forth below.)

### **ARGUMENT**

Appellant stands by the arguments presented in the January 13, 2005 Appeal Brief, as supplemented by Appellant's response to the March 10, 2006 Examiner's Answer provided below.

#### **Response to Examiner Arguments**

On page 5 of the Examiner's Answer, the Examiner maintains that product-by-process claims are not limited to the manipulations of the recited steps/processes, only the structure implied by the processes. Thus, the Examiner concludes that the "etching" of claim 1 is not relevant and is not part of the claimed structure. The Examiner relies on MPEP §2113. However, similar to Appellant's comments presented in the January 13, 2005 Appeal Brief, the Examiner appears to be misapplying the teachings of MPEP §2113.

MPEP section 2113 provides in part:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "**etched**" are capable of construction as structural limitations.)

(Emphasis added.)

As specifically set forth in MPEP §2113, the term “etched” is capable of construction as a structural limitation.

In the January 13, 2005 Appeal Brief, Appellant set forth an etching example merely for explanatory reasons (pg. 14 of Appeal Brief). In particular, Appellant noted that etched glass is obviously structurally different from non-etched glass. This was provided as a simple explanation to show the Examiner that an etched surface imparts distinctive structural characteristics from a non-etched surface, such as a different appearance, reduction of transparency, increase of sliding resistance, etc. On page 5 of the Examiner’s Answer, the Examiner refers to Appellant’s above example, and maintains that Appellant has not met “a burden of proof as to why etching performs a different structure.” Appellant is unsure what “burden” the Examiner is referring to, but nevertheless, Appellant submits that one skilled in the art would clearly understand that an “etched” surface is structurally different from a non-etched surface.

For the reasons set forth in the January 13, 2005 Appeal Brief, Appellant submits that Nakamura does not teach or suggest the claimed etched partition wall. In this regard, claim 1 is rejected under 35 U.S.C. § 102(b). Under the basic requirements of “anticipation,” Appellant submits that the lack of an etched partition, in Nakamura, is sufficient to render claim 1 patentable over the reference. For example, Nakamura fails to teach or suggest, in any manner, that the spacer 3 (alleged partition wall) is etched. Also, as set forth in the January 13, 2005 Appeal Brief, Appellant submits that a high level of structural accuracy and positioning can be achieved if the claimed structures are formed by etching.

The Examiner further maintains that etching can be performed by using any process in order to obtain the final product and that laser ablation can be used instead of etching (pg. 5 of Examiner's Answer). However, Appellant previously provided reasons as to why the spacer 3 of Nakamura cannot be made as an etched surface due to the specific tapering of certain surfaces (pg. 14 of January 13, 2005 Appeal Brief). In other words, if one skilled in the art wanted to form the specific configuration of surfaces as taught in Nakamura, an etching process would not be used; hence, no "etched" surfaces. The Examiner's statement regarding laser ablation does not cure the deficient teaching of Nakamura.

Based on the foregoing, Appellant submits that claim 1 is patentable over Nakamura.

Further, Appellant submits that the remaining claims, i.e., claims 3, 4, 54 and withdrawn claim 7 are patentable for at least the reasons presented in the January 13, 2005 Appeal Brief. Since the June 10, 2004 Restriction Requirement indicated that claim 1 is considered *generic*, and claim 7 is dependent upon claim 1, Appellant respectfully requests that such claim be rejoined in the Application upon allowance of claim 1.

### **CONCLUSION**

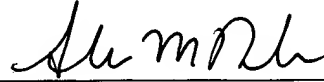
For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal.

REPLY BRIEF  
U.S. Application No.: 09/708,514

Attorney Docket No.: Q61721

An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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